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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,784	01/29/2004	Guido Galley	21453 US	7288
ISI HOFFMANN-	7590 05/09/2007 LA ROCHE INC.	•	EXAM	INER ·
PATENT LAW DEPARTMENT			WARD, PAUL V	
340 KINGSLA NUTLEY, NJ (AND STREET 07110		ART UNIT	PAPER NUMBER
,			1624	
			MAIL DATE	DELIVERY MODE
			05/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	L A I' A' NI-					
	Application No.	Applicant(s)				
	10/767,784	GALLEY ET AL.				
Office Action Summary	Examiner	Art Unit				
	PAUL V. WARD	1624				
The MAILING DATE of this communication app Period for Reply	pears on the cover sheet with the c	orrespondence address				
A SHORTENED STATUTORY PERIOD FOR REPL WHICHEVER IS LONGER, FROM THE MAILING D - Extensions of time may be available under the provisions of 37 CFR 1.1 after SIX (6) MONTHS from the mailing date of this communication. - If NO period for reply is specified above, the maximum statutory period - Failure to reply within the set or extended period for reply will, by statute Any reply received by the Office later than three months after the mailin earned patent term adjustment. See 37 CFR 1.704(b).	ATE OF THIS COMMUNICATION 136(a). In no event, however, may a reply be tin will apply and will expire SIX (6) MONTHS from a, cause the application to become ABANDONE	N. nely filed the mailing date of this communication. D (35 U.S.C. § 133).				
Status						
1) Responsive to communication(s) filed on 27 N	<u>farch 2007</u> .					
2a) This action is FINAL . 2b) ⊠ This	This action is FINAL . 2b)⊠ This action is non-final.					
	Since this application is in condition for allowance except for formal matters, prosecution as to the merits is					
closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.						
Disposition of Claims		•				
4) ☑ Claim(s) 1-24 is/are pending in the application 4a) Of the above claim(s) 5, 7-8, and 20-24 is/s 5) ☐ Claim(s) is/are allowed. 6) ☑ Claim(s) 1-4,6 and 9-19 is/are rejected. 7) ☐ Claim(s) is/are objected to. 8) ☐ Claim(s) are subject to restriction and/or	are withdrawn from consideration					
Application Papers						
9) The specification is objected to by the Examine 10) The drawing(s) filed on is/are: a) acc Applicant may not request that any objection to the Replacement drawing sheet(s) including the correct 11) The oath or declaration is objected to by the Example 11.	epted or b) objected to by the l drawing(s) be held in abeyance. Sec tion is required if the drawing(s) is ob	e 37 CFR 1.85(a). jected to. See 37 CFR 1.121(d).				
Priority under 35 U.S.C. § 119						
12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of: 1. Certified copies of the priority documents have been received. 2. Certified copies of the priority documents have been received in Application No 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). * See the attached detailed Office action for a list of the certified copies not received.						
Attachment(s) 1) Notice of References Cited (PTO-892) 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date	4) Interview Summary Paper No(s)/Mail Da 5) Notice of Informal P 6) Other:	ate				

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DETAILED ACTION

Election/Restrictions

- 1. Claims 1-24 are pending in the application.
- 2. Applicant's election of Group I in the reply filed on March 27, 2007 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
- 3. Applicant is entitled to have the method claims (Groups VIII and XV), which are commensurate in scope with the elected invention, rejoined if the compounds of Group I are allowed.
- 4. Applicant reserved the right to file a divisional application to the non-elected subject matter.
- 5. An action on the merits on Claims 1-4, 6, and 9-19 is contained herein.

Claim Objections

6. Claim 6 states "coompound" instead of compound. Correction is required

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

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F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-4, 6, and 9-19 are rejected on the ground of nonstatutory double patenting over claims 1-3 and 21-24 of U. S. Patent No. 7,160,875. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims overlap in claimed subject matter. The compound, of example 186, in the instant application is also embraced by U. S. Patent No. 7,160,875. The overlap exist when in the instant case R¹ is

(structure a) and R² is a cycloalkyl substituted by phenyl and two fluoro groups.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL V. WARD whose telephone number is 571-272-2909. The examiner can normally be reached on M-F 8 am to 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Paul V. Ward

Examiner

Technology Center 1600

HABTE KAHSAY

Primary Examiner

Technology Center 1600